

AMENDMENT under 37 C.F.R. § 1.116
U.S. Appl. No. 09/024,885

REMARKS

By this amendment Applicant amends claims 128, 141 and 143 into independent form and cancels claims 157-163 thus claims 80-85, 94, 117-126, 128 and 133-156 are all the claims pending in the application. Claims 128 and 141-143 are objected to and claims 80-85, 94, 117-126, 133-140 and 144-163 stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

ENTRY OF AMENDMENT.

Applicant believes the foregoing amendments should be entered under 37 C.F.R. 1.116 as they do not present any new issues for consideration and/or require additional search. Applicant merely amends claims into independent form to include limitations from base/intervening claims from which they previously depended. Furthermore, the foregoing amendments clarifies issue for purposes of appeal.

OBJECTIONS.

Claims 128 and 141-143 are indicated as including allowable subject matter but are objected to as depending from rejected base/intervening claims. Applicant kindly thanks the Examiner for the indication of allowable subject matter in these claims and by this amendment claims 128, 141 and 143 are amended into independent form. Applicant respectfully submits that the foregoing amendments do not narrow the literal scope of the claims since the dependent claims already inherently included the limitation of the amendments by virtue of their dependencies. For the foregoing reasons, reconsideration of this objection is respectfully requested and at least claims 128 and 141-143 should be allowable.

CLAIM REJECTIONS.

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35 U.S.C. § 103

Rejections based on Aldous '404

1. Claims 80-85, 94, 117-123 and 133-140 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,183,404 to Aldous et al. (hereinafter referred to as "Aldous") in view of one or more of U.S. Patent No. 4,944,698 to Siemon et al. (hereinafter "Siemon"), U.S. Patent No. 4,241,974 to Hardesty, U.S. Patent No. 4,611,875 to Clarke et al. (hereinafter "Clarke"), and/or Research Disclosure No. 317 (hereinafter "Research Disclosure") Applicant respectfully traverses this rejection for the following reasons.

The Office Action admits that Aldous fails to teach or suggest a receptacle module for insertion into the card body to form a unitary module (e.g., as claimed in clams 80, 133, 139). The Office Action instead relies on the secondary references to make up for this deficiency alleging "it would have been obvious to use such an adapter (referring to adaptors of secondary references) with the Aldous card 40 to provide added functions or a mating direction change." Further, the Office Action entirely ignores the limitations in the pending claims that the unitary module (i.e., the card including the inserted receptacle module) has a length within the PCMCIA Type III standard.

It is respectfully submitted that a *prima facie* case of obviousness has not been established since: (i) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings as suggested in the Office Action; and (ii) even when combining the cited references as suggested, the prior art references when combined fail to teach or suggest each and every claim limitation. Without both of these elements, a *prima facie* case of obviousness is not established and a rejection under 35 U.S.C. § 103(a) is improper (MPEP 2143).

(i) **THERE IS NO MOTIVATION TO COMBINE REFERENCES**

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The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the instant case it is alleged that the various telephone adaptors disclosed by the secondary references would be obvious to combine with the card body 40 in Aldous Fig. 8. Applicant respectfully disagrees. For example, Siemon discloses a dual modular jack adapter for insertion directly on a telephone terminal block (Abstract) for use as a break testing bridge adapter (Col. 6, ll. 36-37). Applicant is unaware of any reason why the skilled artisan would conceivably need or use a break testing bridge adaptor for the PCMCIA communications card 40 disclosed by Aldous.

Hardesty discloses an adapter 11 for connecting two telephone cords to a wall terminal 14 as opposed to a card body. Essentially adapter 11 is a splitter for connecting two phones to a wall terminal. While it is conceivable that adapter 11 could potentially be inserted into Aldous card 40, there is no objective reason that Applicant is aware of for doing so.

Clarck discloses a cross-connect field power adaptor for use in connecting electrical power to a telephone station. Once again, Applicant is unaware of any conceivable purpose for combining a cross-connect field power adaptor with the PCMCIA card 40 disclosed by Aldous.

Research Disclosure discloses a device for providing integrated digital network (ISDN) wiring termination. There is no teaching or suggestion why an ISDN wiring termination adaptor would be combined with the PCMCIA cards disclosed by Aldous.

Since there is no motivation for combining the adaptors of the secondary references with the PCMCIA card disclosed by Aldous, the rejection of claims 80-85, 94, 117-123 and 133-140 under 35 U.S.C. § 103(a) is improper.

(ii) THE RESULTING COMBINATOIN FAILS TO TEACH THE CLAIMED LIMITATIONS

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Even assuming that it would be proper to combine the references as suggested by the Office Action (*arguendo*), the resultant combination would still fail to teach or suggest an overall length of the unitary module (i.e., card body + receptacle module), in a configuration, that is within the PCMCIA Type III standard.

The Office Action alleges that it would be obvious to shorten the length of card 40 or form adapters of small size. However, Applicant submits that since a unitary module having the claimed size limitations are not taught or suggested by any prior art reference or combination of references, and plainly, insertion of the various adapters from the secondary references to the Aldous PCMCIA card body 40 would not satisfy these claimed limitations, the claims cannot be rendered obvious.

Applicant directs the Examiner to the URL pcwebopedia.com/TERM/P/PCMCIA.html for improved understanding which shows all PCMCIA compliant cards (Types I, II or III) have rectangular dimensions of no larger than 85.6 x 54 mm.

Because the suggested combination of prior art references is improper and because taken alone or in combination the prior art references fail to teach or suggest each and every claimed limitation, Applicant respectfully submits a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established. Accordingly, reconsideration and withdrawal of the §103 rejections based on Aldous is respectfully requested

2. Claims 124-126 and 150-156 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aldous in view of U.S. Patent No. 5,395,268 to Okada (hereinafter "Okada '268"). Applicant respectfully traverses this rejection for the following reasons.

Okada '268 discloses a modular jack 26 formed in a case of an IC card 28. (Col. 5, ll. 42-48). Jack 26 includes a box 40 and a bottom portion 18 of box 40 has a "function of stopping the insertion push direction of the modular plug 14." (Col. 5, ll. 54-57).

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The Office Action alleges it would be obvious to combine the movable bottom 18 of Okada '268 with the pivoting retractable access portion 72 (Fig. 13) of Aldous to "*provide a stop for the plug*" and/or "*add a degree of environment sealing for the plug contacts.*" Applicant respectfully submits that proposed motivation for combining the references is improper since Aldous already includes a stop for the plug. This is disclosed at col. 17, ll. 17-22 where it is stated that the communications card may be provided with a ledge 126 (Fig. 15) for preventing passage of the contact pin block completely through the aperture in the communications card.

Since Aldous already discloses ledge 26 as a stop, the skilled artisan would not look to combine the movable bottom 18 of Okada '268 to "provide a stop for the plug" as alleged in the Office Action. Moreover, since Okada '268 is entirely silent on the aspect that movable bottom 18 may serve to seal plug contacts from the environment, Applicant can only assume such motivation for modifying the Aldous jack with the teaching of Okada '268 is piecemeal reconstruction of Applicant's claims based on improper hindsight of Applicant's disclosure. Since no proper motivation exists for combining Okada '268 with Aldous a *prima facie* case of obviousness has not been established and the §103 rejection of Applicant's claims based on this combination should be withdrawn. It is further noted that neither reference teaches or remotely suggests the bevel feature recited in dependent claim 151.

Regarding the comments about the priority date of the instant application, Applicant directs the Examiner to the expandable member 114 disclosed in the earliest priority document, U.S. Patent 5,411,405 filed. Applicant submits expandable member 114 cannot be considered anything other than a "movable bottom" which isolates contacts 20 from the surrounding environment.

Rejections based on Kerklann and/or Okada '442

Claims 144-149 and 157-163 are rejected as being anticipated under 35 U.S.C. § 102(e) and/or unpatentable under 35 U.S.C. § 103(a) in view of U.S. 5,634,802 to Kerklaan or U.S. 5,538,442 to Okada (hereinafter "Okada '442"). Applicant notes that neither Kerklaan nor

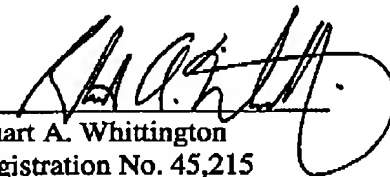
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Okada '442 qualify as prior art against claims 144-149 since these claims are entitled to an effective filing date of November 12, 1993. (See for example, Figs. 12 and 13 of the earliest priority document). As claims 157-163 have been cancelled by the foregoing amendments, reconsideration and withdrawal of these rejections are respectfully requested.

CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to **Deposit Account # 50-0221.**

Respectfully submitted,


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